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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,811	11/13/2003	John T. Keane	K0021.70002US00	8844
7590	07/25/2007		EXAMINER ADDISU, SARA	
David Wolf Wolf, Greenfield & Sacks, P.C. 600 Atlantic Avenue Boston, MA 02210			ART UNIT 3722	PAPER NUMBER
			MAIL DATE 07/25/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/712,811	KEANE, JOHN T.
	<b>Examiner</b> Sara Addisu	<b>Art Unit</b> 3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 22 June 2006.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-5 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-5 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 13 November 2003 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date .

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application

6)  Other: \_\_\_\_\_

## DETAILED ACTION

This Office Action is in response to the amendment filed 6/22/06. New claim 5 has been added. Currently, claims 1-5 are pending in this application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ong (USP 5,566,979), in view of Bhatia et al. (USP 5,120,176).

ONG teaches a multipage document holder comprising a front panel (16) and a back panel (18) formed of a single piece, whereby the with the spine defined from the front and back panels by fold line (20) defining a hinge ('979, figures 1 and 2). ONG also teaches a holder (90) integrally formed of flexible plastic, the holder comprising an angularly formed elongated member with a first leg (94) forming a back and a second leg (98) forming a loop defined from one another by a line of reduced thickness (92) of the elongated member extending lengthwise of the member, the second leg (98) defining an elongated opening (50) extending across a majority of the major length of the holder ('979, figures 11 & 12 and col. 6, lines 2-25). Furthermore, ONG teaches the size of the slot (50) can be selected therefore it reads on the claimed subject matter of

opening (50) having "a width extending laterally across a majority the major portion of the second leg (98). ONG also teaches adhesive (70) being used to secure the first leg (94) to the back panel (18). Regarding claim 4, ONG teaches in figure 5, the loop extending substantially the length of the holder. Regarding claim 5, ONG teaches in figure 11, an angle being formed between the first and second legs (94, 98), and necessarily the reduced thickness (92) allows the angle to reach approximately 90 degrees. Please note that the phrase "a medical record binder for medical records and x-rays" and "..folder for receiving and retaining medical records and x-ray film negatives" (claimed in claims 1 and 2) is merely functional/intended use not defining any specific structure and only requires prior art references to be capable of said intended use. See MPEP 2114.

However, ONG fails to teach the an intermediate spine being formed between the front and back panels, the spine being defined from the front and back panels by spaced parallel segments of reduced thickness defining a hinges. ONG also fails to teach the binder being made of plastic.

BHATIA ET AL. teaches a binder having a front panel (21, a back panel (15) and an intermediate spine (18-2) formed between the front and back panels (21, 15), the spine (18-2) being defined from the front and back panels by spaced parallel segments of reduced thickness (19-1 through 19-4) of the plastic material, spaced parallel segments of reduced thickness defining a hinges ('176, figures 1-4 and col. 3, lines 54-66). BHATIA ET AL. also teaches in figure 3, the spaced parallel segments (19-1 through 19-4) defining the thickness of the spine (18-2) and extending from one edge to

the other edge of the binder ('176, figure 3). Furthermore, BHATIA ET AL. teaches the binder being made of plastic amongst other options ('176, col. 3, lines 54-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify ONG's invention such that it incorporates an intermediate spine between its front and back panels, as taught by BHATIA ET AL. for the purpose of having a binder that is adaptable to preferred size depending on its use since the width of the intermediate spine can be sized accordingly ('176, col. 3, lines 61-66). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize plastic material for ONG, as taught by BHATIA ET AL., for the purpose of having a durable record holder that also protects records from accidental wetness. Regarding claim 3, the modified device of disclosed the claimed invention (i.e. the first leg (94) being secured to binder using adhesive 70), except for the attachment rivets. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the use of adhesive with rivets because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-4 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Addisu at (571) 272-6082. The examiner can normally be reached on 8:30 am - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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SA  
7/23/07

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